REMARKS

Pursuant to 37 C.F.R. §1.116, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-7 and 9-21 are presently pending before the Office, with claims 6, 7, 9-14 and 19-21 being withdrawn from consideration due to a restriction requirement. Applicants have amended the claims. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicants is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed May 14, 2003 (Paper No. 9) and the references cited therein have been carefully studied by Applicants and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

Relying on 35 U.S.C. §102(b), the Examiner has rejected the subject matter of claims claims 1-5 and 15-18 as being anticipated by Booth, et al. Applicants respectfully traverse the rejection and request reconsideration.

Applicants respectfully submit that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

The Booth reference fails this test in light of amended claims 1-3, wherein the compound represented by formula (II) is produced on one of the processes claimed in original claims 6, 11

or 14. The present invention was established on the fact that a raw material of the formula (II) can be obtained at short steps as discussed further in Applicants' amendment filed February 10, 2003, which is hereby incorporated by reference herein. Accordingly, each and every element of Applicant's claims have not been taught in that single reference. Accordingly, Applicants respectfully submit that the non-withdrawn claims, as amended, have not been anticipated by the patent under 35 U.S.C. §102(b), and respectfully requests that such rejection be withdrawn.

Relying on 35 U.S.C. §103(a), the Examiner has rejected the subject matter of 1-5 and 15-18 as obvious over Booth et al. Applicants respectfully traverse the rejection and request reconsideration.

It is evident that Applicants' invention is decidedly different from the teachings of the Booth reference for the reasons stated above, which are incorporated by reference herein.

Clearly, in the absence of any suggestion or of any teaching whatsoever of how one skilled in the art would attempt to use the Booth reference with its low yield to produce the present invention and its effectively greater yield in a short step, one skilled in the art would certainly not find ample motivation to use the Booth the reference to arrive at the present invention.

The Office has used the claimed invention as a reference against itself as if it had preceded itself in time. Legal authority invalidates such an analytical or reverse engineering approach to patent examination. It is not Applicants' burden to refute the Office's position that it would have been obvious to one of ordinary skill in this art at the time this invention was made to arrive at the present invention in view of the Booth reference. It is the burden of the Office to

show some teaching or suggestion in the reference to support this allegation. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d at 1051, 5 U.S.P.Q.2d at 1438-39 (Fed. Cir. 1988).

A finding by the Office that a claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made based merely upon finding similar elements in a prior art reference would be "contrary to statute and would defeat the congressional purpose in enacting Title 35." Panduit Corp. v. Dennison Mfg. Co., 1 U.S.P.Q.2d 1593 at 1605 (Fed. Cir. 1987). Accordingly, Applicants respectfully submit that the pending claims, as amended, are patentable over the Booth reference under 35 U.S.C. §103(a). Withdrawal of the rejection is respectfully requested.

CONCLUSION

As the Federal Circuit observed in Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 217 U.S.P.Q. 193 (Fed. Cir. 1983):

> The question of nonobviousness is a simple one to ask, but difficult to answer ... The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness ...

Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 538-3800 would be appreciated.

Very respectfully,

Dated: 7/10/03

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